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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,899	09/28/2001	Markku Koulu	2630-111	5535

6449 7590 09/22/2004

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EXAMINER

KELLY, ROBERT M

ART UNIT PAPER NUMBER

1632

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/937,899

Applicant(s)

KOULU ET AL.

Examiner

Robert M Kelly

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: NONE.

Claim(s) objected to: 4-7 and 11.

Claim(s) rejected: 8, 14 and 15.

Claim(s) withdrawn from consideration: NONE.

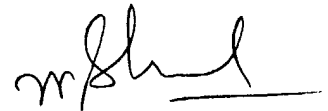
8. ☒ The drawing correction filed on 30 August 2004 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER

Continuation of 2. NOTE: e.g., The proposed amendment to Claim 8, as well as proposed amended Claim 14 and proposed new claim 16 will require a new search because Claim 8 recites a SEQ ID NO. The claims at the time of final rejection did not encompass any such SEQ ID NO. Proposed Claims 14 and 16 also encompass the same SEQ ID NO. Additionally, Applicant's new terms of complementarity in proposed Claim 8 and proposed newly presented Claim 16 may raise new matter issues.

Continuation of 3. Applicant's reply has overcome the following rejection(s): The written description rejection to Claims 8, and 14-15 will be withdrawn in light of the cancellation of Claim 15 and the amendments of Claims 8 and 14, when the amendments are entered.

Continuation of 5. does NOT place the application in condition for allowance because: The arguments with regard to enablement are not considered persuasive in view of the general unpredictabilities in the art, as discussed in the previous rejections (Official Action of 1/15/04, page 10; Official Action of 6/30/04, pages 6-9). While Lebedeva provides for a promising future, it does not enable Applicant's gene therapy invention, because gene therapy is specific for disease, gene, vector and route of administration, as addressed in the previous office actions (Id.). Moreover, Lebedeva has not been addressed by Applicant in the previous responses. Applicant's submission of US Patent Application Publication No. 2004/0006004 was similarly not offered previously. Additionally, the patentability of the invention has not yet been determined.



RAM R. SHUKLA, PH.D.
PRIMARY EXAMINER